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Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

In the Matter
of the
APPLICATION OF FREDERICK C. FOSTER, *Petitioner*

PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS

EDWARD S. IRONS
1000 Connecticut Avenue, N.W.
Washington, D. C. 20036
Attorney for Petitioner

Of Counsel:

STANLEY M. CLARK
c/o The Firestone Tire & Rubber Company
1200 Firestone Parkway
Akron, Ohio

MARY HELEN SEARS
1000 Connecticut Avenue, N.W.
Washington, D. C. 20036

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APPLICATION OF FREDERICK C. FOSTER, *Petitioner*

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS

Petitioner prays that a writ of certiorari issue to review the decree of the United States Court of Customs and Patent Appeals entered in the above-entitled case on April 15, 1965.

CITATIONS TO OPINIONS BELOW

The opinion of the United States Court of Customs and Patent Appeals (App., pp. 5a-41a) is reported at 343 F.2d 980. Both the original decision of the Patent Office Board of Appeals (App., pp. 65a-70a) dated May 29, 1962 and its decision on reconsideration (App., pp. 71a-73a) dated September 17, 1962 are unreported.

JURISDICTION

The decree of the Court of Customs and Patent Appeals was entered on April 15, 1965 (App., p. 5a). On July 1, 1965 a timely petition for rehearing was denied (App., p. 42a) and the court entered an order staying enforcement of the April 15, 1965 decree until fifteen days from the termination in this Court of any proceedings which may result from this petition (App., p. 42a).

The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

QUESTIONS PRESENTED

1. Can the "time-bar" provision of 35 U.S.C. 102(b) properly be extended by construction of the words "described in a printed publication" as used in that statute to deny to an applicant or a patentee the right, guaranteed by 35 U.S.C. 103, to have the question of whether or not the invention is "obvious" determined on the basis of "the subject matter as a whole . . . at the time the invention was made"?

2. Is the Court of Customs and Patent Appeals foreclosed by procedural due process and the statutory limits of its jurisdiction from rejecting an appellant's claim, *sua sponte*, on grounds which the Patent Office never advanced and concerning which the appellant was never notified or given an opportunity to be heard?

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This case involves Article I, Section 8, clause 8 of the Constitution (App., p. 1a) and 35 U.S. Code §§ 6, 102(a) and (b), 103, 132, 144 and 282 (App., pp. 1a-4a). It also involves R.S. 4886, as amended (App., p.

4a), which was repealed when the Patent Code of 1952 was passed and was recodified, insofar as pertinent here, in 35 U.S.C. 102(a) and (b).

STATEMENT

The Court of Customs and Patent Appeals, one judge dissenting (App., pp. 28a-41a), has held that the question of whether an invention is "obvious" shall *not* be determined as of "the time the invention was made" as 35 U.S.C. 103 expressly provides.

By "construction of section 102(b)" (App., p. 22a) the court has held that an invention is unpatentable, notwithstanding the provisions of section 103, if the subject matter became obvious more than one year before the applicant filed his application.

This extraordinary result rests on an interpretation of the clause "described in a printed publication" in 35 U.S.C. 102(b) to include references in which the "invention is . . . not described as set forth in section 102" and heretofore cognizable only as evidence of "obviousness" under 35 U.S.C. 103.[1]

This decision expressly reverses the unanimous 1963 decision of the same court in *Application of Palmquist*, 319 F. 2d 547.[2] It destroys any meaningful distinction between sections 102(a) and (b) and section 103 and

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[1] The pertinent portion of section 103 includes, in terms, printed publications *not* cognizable under 35 U.S.C. 102(b).

35 U.S.C. 102(b) is limited to "printed publications" in which the invention is "described."

35 U.S.C. 103 is addressed, *inter alia*, to references including printed publications in which "the invention is not . . . described as set forth in section 102. . . ."

[2] The decision in *Palmquist* was rendered by a four-judge court. Chief Judge Worley did not participate.

hence conflicts directly with the court's many contemporaneous decisions construing these statutes. It presents a superficially facile solution to a number of difficult questions which reach to the very roots of the patent system. And in so doing, it conflicts with many authoritative decisions of this Court.

The decision below is not an isolated instance of a "hard case" making bad law. This is a landmark decision. It has already been followed and reaffirmed in two cases by the court below, *viz., Application of Folkers,* 344 F. 2d 967 (1965) (App., pp. 43a-48a) and *Application of Hassler,* —F. 2d —, decided July 1, 1965 (App., pp. 48a-64a).

The Patent Office considers itself bound by, and is now following, these decisions. The issues involved are raised in virtually every patent application examined by that agency—and in nearly all infringement litigation in the federal courts, including the Court of Claims.[3]

No review is available except in this Court.

The case originated as an appeal under 35 U.S.C. 141 from the refusal of the Patent Office to allow petitioner any claims in his U.S. patent application Serial No. 605,440, filed August 21, 1956.

The subject matter to which the application relates is a new kind of synthetic rubber characterized by exceptional properties not demonstrated by any syn-

[3] Questions involving the interpretation of sections 102(a) and (b) and 103 come before such courts by virtue of the provisions of 35 U.S.C. 282 that patent validity may be challenged "on any ground specified in Part II of this title as a condition for patentability." "Part II" includes sections 102 and 103, both of which are partially captioned "Conditions for Patentability. . ."

thetic rubber known at the time the invention was made. The record shows that the new synthetic rubber could not be made by any previously known procedures.

The court below recognized that petitioner had made an invention. It reversed the Patent Office rejection on certain of the claims in issue but "affirmed" the Patent Office as to others.

The claims with respect to which the rejection was "affirmed" fall in two categories. The first category includes those claims which define products, but recite no method limitations. The second category includes claims, otherwise similar to those of the first category, but which additionally recite certain method limitations that distinguish from the reference as applied. The court below refused, in its original decision and on request for rehearing, to give any consideration whatever to such method limitations. It refused as to both categories of claims to consider the "subject matter as a whole" as expressly required by 35 U.S.C. 103.

The single reference advanced by the Patent Office and considered by the court below was a publication of one Binder.

The court below acknowledged that:

> "Proofs submitted in this case . . . have established that the applicant's invention date was prior to December 26, 1952. The Binder reference is the August 1954 issue of a periodical. It is seen, therefore, that it is *subsequent* to the *date of invention* but more than one year prior to the filing date, which was August 21, 1956. . . ."[4] (App., p. 14a)

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[4] Unless otherwise noted, all emphasis herein is added.

The Patent Office affirmatively recognized that the rejection which the decision below purports to affirm is cognizable under 35 U.S.C. 103—and *only* under 35 U.S.C. 103. It was discussed in the Patent Office Solicitor's brief under the caption, "The rejection under section 103." The opening sentence of the pertinent section of the Solicitor's brief states:

> "The basis of the rejection of the claims predicated on Section 103 is Binder's disclosure A."[5] (S. Br. 15)

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[5] The rejection on Binder affirmed by the Patent Office Board of Appeals was set forth in the Examiner's Answer (R. 199-204) under the heading, "The Rejection." It is reproduced verbatim in the Board's original May 29, 1962 opinion (App., p. 66a). The Examiner lumped *all* of the claims together and "rejected" them "as *unpatentable over* Binder" R. 201, App., p. 66a). The Answer further stated:

> ". . . The Examiner is cognizant that the properties of the polymers defined by the claims differ from those disclosed by the reference; . . . " (R. 201, App., p. 66a)

On this basis, petitioner's contention in the court below was that "The Rejection" was premised upon 35 U.S.C. 103 *alone*. The Solicitor, however, urged in his brief:

> ". . . that different parts of Binder (disclosures A and B) were relied upon as though they were, in fact, two separate references, one part being the basis of a rejection under Section 102, [disclosure B] and another part [disclosure A], under Section 103, . . ." (S. Br. 9)

Under the heading, "The rejection under Section 102," the Solicitor relied upon "disclosure B" as a "full disclosure" (S. Br. 11) of the claimed polymers. "Disclosure B" was urged by the Solicitor to be ". . . a proper *anticipation* under Section 102, . . ." (S. Br. 15) because, he insisted, that disclosure described the subject matter defined by the appealed claims. This "rejection under Section 102" was *reversed* by the court below.

[In this petition "R." refers to the printed record in the court below; "S. Br." designates the Solicitor's Brief in the court below. Both are included in the certified materials transmitted to this Court for use in preparing the record.]

The majority below properly characterized "The rejection under section 103" as involving ". . . *differences* between the claimed subject matter and the reference disclosure which the Patent Office contends would be *obvious* to one of ordinary skill in the art, . . ."[6] (App., p. 15a)

This characterization of the rejection by the court is substantially in the language of 35 U.S.C. 103 on which it was exclusively predicated by the Solicitor. That statute provides in pertinent part:

> "§ 103. Conditions for patentability; *non-obvious subject matter*
>
> "A patent may not be obtained though the *invention is* **not . . . described** *as set forth in section 102 . . . if the* **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole** would have been **obvious** *at the time the invention was made* . . ."

It was petitioner's position below that since Binder, a 1954 publication which did *not describe* the inven-

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[6] 35 U.S.C. 103 requires a consideration of whether "the differences between the subject matter sought to be patented" and the reference "are such that the subject matter *as a whole* would have been obvious . . ." A major fallacy indulged by the Patent Office and perpetuated by the majority below in this case is that consideration was given only to the "obviousness" of the *differences* between Binder's products and those claimed by petitioner. No effort was made to compare petitioner's claimed subject matter *as a whole* with Binder's teachings to determine "obviousness." In particular, both bodies failed to consider that Binder neither discloses nor otherwise suggests a method for preparing products having the attributes of those claimed by petitioner. Note the inconsistent approaches of the same court in the *Riden* case, footnote 9, *infra*, pp. 11-12, and in each of the *LeGrice, Petering, Sheppard* and *Ruschig* cases discussed *infra*, pp. 28-33.

tion, did not exist "at the time the invention was made" in 1952, the rejection was foreclosed by the express language of 35 U.S.C. 103.

Petitioner relied upon the unanimous July 1963 decision of the court below in *Application of Palmquist,* 319 F. 2d 547. The majority recognized that *Palmquist* required a reversal of the Patent Office as to all of petitioner's claims since the "differences in the factual situations" were "of no legal significance." (App., p. 15a)

In *Palmquist,* as in the case at bar, a reference not describing the invention and relied upon to support a rejection under section 103, was shown to have an effective date subsequent to the applicant's invention date but more than one year prior to the time the application was filed.

In *Palmquist,* after review of the relevant authorities, the court held that such a reference was not competent evidence of "obviousness" under 35 U.S.C. 103, since it did not exist "at the time the invention was made" as the statute required. The court said:

> "The position of the examiner, affirmed by the board, is, in effect, that the claims are properly rejected under 35 U.S.C. § 103 if the claimed invention was obvious to one of ordinary skill in the art *at the time the application was filed.*[7] (Emphasis by the court)

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[7] This is the same position taken by the Solicitor in his Petition for Rehearing in *Palmquist.*

In this case, the court in effect held that claims are properly rejected under 35 U.S.C. 103 if the claimed invention was obvious to one skilled in the art a year prior to the time the application was filed, rather than "at the time the invention was made" as expressly required by 35 U.S.C. 103.

"35 U.S.C. § 103 was a *new* provision in the Patent Act of 1952. Its purpose was to take the place of the *case-law* requirement of 'invention' which developed during the preceding century. The *many cases* in which the requirement of 'invention' was stated had an underlying concept, namely, that the presence of 'invention' was to be determined as of the time the invention was made. This concept is now expressed in 35 U.S.C. § 103.

"As stated in In re Rothermel and Waddell, Jr., 276 F. 2d 393, 47 CCPA 866:

> '* * * 35 U.S.C. § 103 is very specific in requiring that a rejection on the grounds the invention "would have been obvious" must be based on a comparison between the prior art and the subject matter as a whole *at the time the invention was made.*' (Emphasis by the court)

See also In re Murray and Peterson, 268 F. 2d 226, 46 CCPA 905. [319 F. 2d at 550]

* * * *

"We think both logic and reason require us to interpret the provisions of 35 U.S.C. § 103 in accordance with *the legal principles which preceded* and are *codified* in it. The *principles established before 1952* required that the time as of which the determination of 'invention' was to be made was 'the time the invention was made.' They apply equally to the determination of obviousness under 35 U.S.C. § 103." [319 F. 2d at 551]

The opinion of the majority below after an "unusually long time" in "gestating" expressly overruled *Palmquist.*[8]

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[8] The quotations are from the concurring opinion below of Judge Rich (App., p. 28a). The case was argued below on February 11, 1964. The decision was not rendered until April 15, 1965. A Petition for Rehearing filed by the Patent Office in *Palmquist* was summarily denied on January 17, 1964.

"Because of the importance of the question to the law of patents, . . ." the majority below, *sua sponte,*

> ". . . deemed it desirable to reconsider what is the statutory basis of this 'unpatentable over' or obviousness type of rejection, such as we have here and had before us in Palmquist, . . ." (App., pp. 15a-16a)

As a result of such reconsideration, the majority rejected the construction of 35 U.S.C. 103 urged by the Solicitor. It recognized that "The rejection under section 103" could not be sustained by any tenable "construction" in view of the express mandate of that statute that the issue of obviousness be determined "at the time the invention was made."

For this reason, the majority disclaimed any reliance on 35 U.S.C. 103, the only statute which in terms relates to obviousness. Instead, the majority asserts its decision "is predicated on our construction of 35 U.S.C. 102(b)."

Section 102(b) is not concerned with obviousness at all. It is limited in terms to "printed publications" in which the invention is "described."

Section 103 is exclusively concerned with obviousness. Section 103, by its express terms, extends to the very references *excluded* by section 102(b). It specifically contemplates printed publications in which the "invention is not . . . described as set forth in section 102. . . ." It requires for patentability that the "differences" between "the invention as a whole" and printed publications, such as the Binder publication in this case, in which the invention is *"not . . . described"* be unobvious to a person of ordinary skill in the art "at the *time* the invention was made."

As a prerequisite to predicating its decision on 35 U.S.C. 102(b), the majority framed an entirely *new* issue which it then decided. Disregarding the express language of both the relevant statutes—and the statutory limits on its jurisdiction as well—that *new* issue, as stated by the majority, was

> "... whether there was a loss of right to a patent, i.e., whether the invention became obvious to the public at the time of the Binder publication. ..." (App., p. 23a)

—a date more than one year before the petitioner's filing date.

Nor was the majority content to deny petitioner the right to have the question of "obviousness" determined "at the time the invention was made." By shifting the basis of rejection from section 103 to section 102(b), the majority sidestepped the further requirement of section 103 that obviousness is to be judged in light of "the subject matter as a whole." Instead, the court considered the "differences" between Binder's teachings and the subject matter claimed by Foster in light of mere "mechanistic overlaying" of similarities,[9] and

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[9] The quotation is from the opinion of the court below in *Application of Riden*, 318 F.2d 761 (1963). In that case the court stated:

> "As to the method of making the compounds claimed being different from Boehme et al., we agree with appellants that this fact is relevant. Chemical cases should not be decided solely on the basis of homology or analogy in structural formulae. *The determination of obviousness is not the mechanistic overlaying of chemical formulae. ...*" [318 F.2d at 764]

The court below has repeatedly condemned the "mechanistic" rejection of chemical compound inventions for "obviousness", recognizing that such treatment denies consideration to "the subject matter as a whole." See, *inter alia*, *Application of Lunsford*,

in total disregard of "the subject matter as a whole." In particular, the majority refused both in its original decision (App., p. 26a) and on request for reconsideration (App., p. 42a) even to consider the failure of the reference to disclose or suggest any process for preparing petitioner's claimed products—a deficiency emphasized by the method limitations which are part of the description of the invention in the category 2 claims.

Thus, the majority "affirmed" a new rejection of its own creation—a rejection which the Patent Office had never made and concerning which appellant below, petitioner here, had never been notified or given an opportunity to be heard.[10]

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327 F.2d 526 (1964), and *Application of Ward*, 329 F.2d 1021 (1964).

The position of the majority below is wholly inconsistent with its previous condemnations of this "mechanistic" approach to "obviousness" of chemical compounds. Moreover, it is irreconcilable with the *reaffirmation*, one week after the decision below, of the *Riden, Lunsford* and *Ward* cases in *Application of Ruschig*, discussed *infra*, pp. 32-33. The result is manifest uncertainty as to the criteria to be applied in determining "obviousness" of chemical compounds.

[10] The same maneuver was executed by the majority for precisely the same purpose in *Application of Folkers*, 344 F.2d 967, decided by the court below on May 20, 1965. In Judge Smith's dissent in *Folkers* he pointedly observed:

> "To me it is unconscionable that an applicant can now receive a rejection from the Patent Office on one statutory ground, and then, on appeal from that rejection, receive a wholly new rejection from this court which is based on an entirely *different* statutory ground. I would reverse." (App., p. 48a) [344 F.2d at 970]

The respective positions of the parties in this case concerning the *nature* of the Patent Office rejection as "unpatentable over"

REASONS FOR GRANTING THE WRIT

Succinctly stated, this petition should be granted because:

(a) The questions presented are fundamental to the Court's elucidation, this term, of the conditions for patentability defined in 35 U.S.C. 102 and 35 U.S.C. 103.

(b) The decision below is premised on an interpretation of R.S. 4886 which is totally inconsistent with the controlling decisions of this Court as understood by Congress at the time the 1952 Act was passed.

(c) The decision below, in violation of the relevant principles of statutory construction enunciated by this Court, destroys any meaningful distinction between sections 102(a) and (b) and section 103.

Binder are discussed in footnote 5, *supra,* p. 6. After considering these respective contentions, the court below held:

> "We agree that the language employed is confusing and that it is not clear what section of the statute is intended. On the other hand, we are not convinced that there is any 'magic' to the particular words used or that they can only mean reliance on section 103. The words 'unpatentable over' do not *necessarily* mean reliance on section 102 *alone.* The statements of the rejections are sufficient for us to consider the rejections on both sections 102(b) and 103." (Emphasis by the court) (App., p. 11a)

Absent any foundation in the position of either party, the court thus employed the Solicitor's reliance upon section 102(b) as to Binder's "disclosure *B*" as a bootstrap for "sustaining" a section 102(b) rejection on Binder's "disclosure *A*". But the Patent Office never made such a rejection and the Solicitor never contended that it did. The Solicitor's sole contention as to the rejection on "disclosure *A*" was that it was "predicated on section 103."

(d) To the extent that the decision below merges "obviousness" with "anticipation", it conflicts with many decisions of this Court and the federal courts of appeals.

(e) The decision below is in direct conflict with the decisions of this Court construing the "time-bar" provisions of the patent statutes.

(f) The recent decisions of the Court of Customs and Patent Appeals interpreting 35 U.S.C. 102 and 35 U.S.C. 103 are in irreconcilable conflict.

(g) The majority opinion violates procedural due process and exceeds the jurisdiction of the court as limited by 35 U.S.C. 144.

DETAILED STATEMENT OF REASONS FOR GRANTING THE WRIT

1. The Questions Presented Are Fundamental to the Court's Elucidation, This Term, of the Conditions For Patentability Defined in 35 U.S.C. 102 and 35 U.S.C. 103.

For its initial consideration of the prerequisites to patentability defined in the Patent Act of 1952, the Court has selected six cases [11] to be decided this term.

The apparent objective of the Court in accepting these six cases is to provide authoritative guidelines by which the issues of patentability and validity may be determined in the Patent Office and the federal courts.

Resolution of the fundamental questions presented by this petition is an essential prerequisite to the realization of that objective. Informed disposition of five of the pending cases will necessarily depend on this Court's evaluation of the dominating issues presented by this case.

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[11] Nos. 11, 37, 43, 55, 57 and 58.

Four of these pending cases [12] seek an interpretation, in relation to particular "inventions", of the word "obvious" as that word is used in 35 U.S.C. 103. Such interpretation by this Court will necessarily involve an elucidation of the permissible scope of the statutory standard of patentability under the constitutional patent clause. Fundamental to any decision in these cases is a determination of whether the majority below was right or wrong in holding that § 102(b) requires "obviousness" to be determined *not* in light of "the subject matter as a whole . . . at the time the invention was made," as § 103 provides, but, rather, as of one year prior to the patentee's filing date.

To date, briefs on the merits have been filed in only one [13] of these four obviousness cases. In addition to the brief of the petitioners, five briefs *amicus curiae* have been presented. These briefs uniformly urge that Congress, by the enactment of 35 U.S.C. 103, intended to define a standard of patentability lower than that which this Court, prior to 1952, consistently found necessary to an implementation of the requirements of the Constitution. All six briefs are premised in major part upon a "construction" of 35 U.S.C. 103 rested upon the text and the immediate pre-1952 legislative history of that act. That "construction" would result in a "standard of patentability" substantively indistinguishable from the requisites for "novelty" under sections 102(a) and (b) and their predecessor statutes. A dominant theme of all the briefs is that the constitutional mandate "to promote progress in science and the useful arts" is satisfied *even if no advance—or one*

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[12] Nos. 11, 37, 43 and 55.

[13] No. 11.

barely perceptible—is made, providing the patented "contribution" is novel and commercially successful. Thus, these four presently pending cases inherently raise, but avoid directly placing in issue, the relationship, if any, between section 103 and sections 102(a) and (b).

The limited question in No. 57 is whether a "copending patent"—i.e., one issued after the filing date of the application or patent against which it is cited, but filed prior thereto—which is maintained in secrecy in the Patent Office until it issues is admissible under 35 U.S.C. 103 to show the capabilities of a person of ordinary skill in the art.

The case for the petitioner apparently will rest on a "construction" of section 103 in light of section 102 finding alleged support in the legislative history of both acts.

Plenary consideration by this Court of the entirety of both sections 102 and 103, including particularly the paramount issues presented only by this petition, is manifestly essential to a full delineation this term of the guidelines by which patentability and patent validity are to be judged.

2. The Decision Below Is Premised On An Interpretation Of R.S. 4886 Which Is Totally Inconsistent With The Controlling Decisions Of This Court As Understood By Congress At The Time The 1952 Act Was Passed.

The majority opinion below is affirmatively predicated on "our construction of section 102(b). . . ." (App., p. 22a)

Section 102(b) recodified, without change, a portion of R.S. 4886. The Reviser's Note states:

> "Paragraphs (a), (b), and (c) are based on . . . R.S. 4886 . . .

> "No change is made in these paragraphs other than that due to division into lettered paragraphs. . . ."

The Reviser's Note is foursquare with Senate Report No. 1979 [14] which accompanied the bill adopted as the Patent Act of 1952. That report states:

> "Section 102 in paragraphs (a), (b), and (c) repeats the conditions in the existing law relating to novelty." [Senate Report No. 1979, p. 5.]

The majority below necessarily agreed with the Patent Office Solicitor that the rejection was cognizable only under section 103. Absent such agreement, there would have been no point to overruling *Palmquist*. In light of this and the further circumstance that section 102(b) merely recodified R.S. 4886, the majority below was impelled to find, *as the very crux of its opinion,* that R.S. 4886 had always contemplated the same "obviousness" situations now expressly cognizable under 35 U.S.C. 103.

To that end, the majority below held:

> ". . . Under the old law (R.S. 4886, where 102(b) finds its origin) patents were refused or invalidated on references dated more than a year before the filing date because the invention was anticipated or, if they were not then *because there was no 'invention,'* . . . [Emphasis by the court] There was no need to seek out *the precise* **statutory** *basis because it was R.S. 4886 in any event,* read in the light of the Supreme Court's interpretation of the law that there must always be 'invention'. . . ." (App., p. 19a)

Thus, to achieve its objective, the majority conveniently ignored what it had affirmatively recognized in

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[14] Senate Report No. 1979, June 27, 1952, 82nd Congress, Second Session.

Palmquist, namely, that "the Supreme Court's interpretation of the law" *here* relevant recognizes that the prior statute, R.S. 4886, like section 102(b), is limited *in terms* to "printed publications" which "describe" the invention claimed.

Moreover, this crucial determination—that the substance of section 103 was included in R.S. 4886—is inconsistent on its face with the majority's subsequent recognition that section 103 is a *new* statute codifying *decisional* law. In its sole reference to the relevant legislative history, the majority acknowledged:

> "... Its legislative history, which is well known and uncomplicated, shows that section 103 had but a single purpose which was *to add to the statute a provision* to take the place of the *judge-made 'requirement for invention'....*" [15] (App., p. 22a)

This statement conforms identically to Congressional understanding of the controlling decisions of this Court at the time the 1952 Act was passed. Senate Report 1979, on which the majority obviously relied, states:

> "... The *major changes* or innovations in the title consist of *incorporating* a *requirement for invention* in § 103 and the judicial doctrine of contributory infringement in § 271. [Senate Report No. 1979, p. 4]

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[15] In *Application of Papesch,* 315 F.2d 381, 386 (1963), a unanimous court composed of the same five judges who participated in the decision below, stated:

> "As everyone knows, section 103 is the statutory version of what was, prior to January 1, 1953, the effective date of the latest revision of the patent statutes, the judge-made requirement of 'invention.' "

> "Section 103, for *the first time in our statute,* provides a condition which exists in the law and has existed for more than 100 years, *but only by reason of decisions of the courts. . . .*" [Senate Report No. 1979, p. 6]

The "requirement for invention" codified in 35 U.S.C. 103, to which both the majority and the Committee Report advert, was "judge-made" for the very reason that R.S. 4886 did *not* contemplate "obviousness situations" as the majority now affirmatively holds.

The inescapable fact that the constitutionally premised "standard of patentability" now codified in section 103 was never included in R.S. 4886, or in the recodification of that statute without change in section 102(b), is demonstrated by any objective evaluation of the relevant precedent.

The Reviser's Note to section 103 asserts that "the holding of patents invalid by the courts on the ground of lack of invention . . . has been followed since at least as early as 1850"—an obvious reference to the decision sustaining the nonstatutory defense of lack of invention in *Hotchkiss et al* v. *Greenwood et al,* 52 U.S. (11 How.) 248, 13 L. Ed. 683 (1850).

Another pertinent decision of this Court is *Mahn* v. *Harwood,* 112 U.S. 354, 358, 28 L. Ed. 665, 667, 5 S.Ct. 174 (1884), which states:

> ". . . But the statutory defenses are not the only defenses which may be made against a patent. Where it is evident that the Commissioner, under a misconception of the law, has exceeded his authority in granting or re-issuing a patent, there is no sound principle to prevent a party, sued for its

infringement, from availing himself of the illegality, independently of any statutory permission so to do.

* * * *

"In cases of patents for inventions, *a valid defense not given by the statute often arises where the question is, whether the thing patented amounts to a patentable invention.* This being a question of law, the courts are not bound by the decision of the Commissioner, although he must necessarily pass upon it. . . ."

The majority below, ignoring this and other relevant decisions of this Court, supported its finding that R.S. 4886 contemplated "obviousness situations" by reference to Patent Office Rule 131 and its predecessor, Rule 75 (App. 16a-20a). It, accordingly, found that section 103 is governed by a mere Patent Office rule, despite the clear requirement of 35 U.S.C. 6 that Patent Office rules shall be "not inconsistent with law." Thus, the majority below has vested in the Patent Office an authority greater than that of Congress to determine what statutes shall say.

Only this Court can review the propriety of this situation. The court below and the Patent Office are caught in an endless cycle wherein the Patent Office is bound by the decisions of the Court of Customs and Patent Appeals and such court looks, in interpreting the law, to the rules of the Patent Office for guidance. Until this Court takes affirmative action, there is little likelihood that the law as enacted by Congress can or will be followed by either body.

3. The Decision Below, In Violation of the Relevant Principles of Statutory Construction Enunciated By This Court, Destroys Any Meaningful Distinction Between Sections 102(a) and (b) and Section 103.

Without challenge from the majority or from either of the separate concurring opinions, dissenting Judge Smith states:

> ". . . Today's decision destroys any meaningful differences that may have existed in the past between sections 102(a) and (b) and section 103. . . ." (App., p. 38a)

By this ruling, section 103—a "new section" constituting one of only two "major changes or innovations" effected by the 1952 Act—is reduced to a reiteration of section 102(a) which, together with sections 102(b) and (c) merely "repeats the conditions in the existing law relating to novelty".[16]

This conclusion is compelled even by a casual examination of the statute.

The word "described" must have the same meaning in both sections 102(a) and (b) since both sections spring from and recodify the *single* occurrence of that word in R.S. 4886.

Adopting the majority "construction" of the word "described" section 102(a) would provide that a patent shall not be granted if

> "the invention was . . . described in a printed publication . . . *or became obvious* . . . before the invention thereof by the applicant. . . ."

So construed, section 102(a) is the *same* statute as section 103 because the words "at the time the inven-

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[16] The quotation is from Senate Report No. 1979, footnote 14, *supra*, p. 17, at p. 5 thereof.

tion was made" in the latter section are identical in meaning with the words "before the invention thereof by the applicant" in the former.

This result, which renders section 103 a mere redundancy in view of section 102(a), violates the controlling principles of statutory construction enunciated by this Court.

In *Jarecki* v. *Searle & Co.*, 367 U.S. 303, 307, 308, 6 L.Ed. 2d 859, 863, 81 S.Ct. 1579 (1961), this Court said:

> "... The statute admits a reasonable construction which gives effect to all of its provisions. In these circumstances we will not adopt a strained reading which renders one part a mere redundancy. See, e.g., United States v. Menasche, 348 U.S. 528, 538, 539, 99 L ed 615, 623, 624, 75 S Ct 513."

In *Menasche,* this Court in interpreting two separate sections of the Nationality Act of 1940, held:

> "The Government's contentions that § 405(a) does not apply to any phase in the processing of naturalization petitions would defeat and destroy the plain meaning of that section. *'The cardinal principle of statutory construction is to save and not to destroy.'* N.L.R.B. v. Jones & L. Steel Corp. 301 US 1, 30, 81 L ed 893, 907, 57 S Ct 615, 108 ALR 1352. It is our duty 'to give effect, if possible, to every clause and word of a statute,' Montclair v. Ramsdell, 107 US 147, 152, 27 L ed 431, 433, 2 S Ct 391; rather than to emasculate an entire section, as the Government's interpretation requires." [348 U.S. 528, 538, 539, 99 L. Ed. 615, 624, 75 S. Ct. 513 (1955)]

By its amalgamation of the two statutes, contrary to these established principles of construction, the major-

ity below has placed itself in direct conflict with the Court of Appeals for the Eighth Circuit. *That* court, in rejecting a contention that the provisions of section 102(b) should be read in light of section 103, held:

> "The legislative history of the 1952 revision of the Patent laws (Title 35 U.S.C., 1946 Ed.) refutes the contention that § 103 was intended to modify or affect in any way § 102(b). . . ." [Bros Inc. v. Browning Mfg. Co., 317 F. 2d 413, 417 (8 Cir. 1963)]

4. To The Extent That The Decision Below Merges "Obviousness" With "Anticipation", It Conflicts With Many Decisions Of This Court And The Federal Courts of Appeals.

The majority below alleged:

> "It would seem that the practical operation of the prior law was that references having effective dates more than a year before applicant's filing date were always considered to be effective as references, regardless of the applicant's date of invention, and that rejections were then predicated thereon for 'lack of invention' without making the distinction which we now seem to see as implicit in sections 102 and 103, 'anticipation' or no novelty situations under 102 and 'obviousness' situations under 103. . . ." (App., p. 21a)

This statement of the majority is contrary in two respects to "practical operation of the prior law" in this Court and the federal courts of appeals. It is also contrary to "practical operation" of the *present* Patent Act in the courts of appeals. Firstly, a clear line of demarcation *has* been maintained between "obviousness"—i.e., "lack of invention"—and "anticipation" —i.e., "lack of novelty"—as grounds for invalidating patents. Secondly, it has been recognized that the references applicable on the first ground are those extant at the *invention date.*

The autonomy between "obviousness" and "anticipation" recognized by this Court prior to 1952 is illustrated in *Carbice Corp. of America* v. *American Patents Dev. Corp.*, 283 U.S. 420, 75 L.Ed. 1153, 51 S.Ct. 496 (1931). In that case this Court held a patent invalid on both of those two grounds, advancing separate and distinct reasons in support of each ground.

Since the 1952 Patent Act the federal courts of appeals have continued to recognize that "obviousness" under section 103 and "anticipation" under section 102 are independent grounds for invalidation of a patent. Exemplary of this recognition are the 1956 opinion of the Court of Appeals for the Second Circuit in *Helene Curtis Industries* v. *Sales Affiliates*, 233 F. 2d 148, and that portion of the opinion in *McCullough Tool Company* v. *Well Surveys, Inc.*, 343 F. 2d 381 (10 Cir. 1965), which is devoted to consideration of the validity of the Pringle patent.

In *Helene Curtis* the court discussed these separate grounds for invalidation under the respective headings "lack of invention" and "anticipation." Preliminary to both discussions, the court affirmatively recognized that the question of "lack of invention" must be decided on the references existing at the invention date. The court stated:

> "The question of patentable invention depends upon the prior art existing at the invention date of the patent in suit. Consequently, we will preface our discussion of the problem as to invention by an examination of the holding made below that McDonough was not entitled to a preapplication invention date." [233 F. 2d at 155]

This recognition of the need for establishing the invention date as a prerequisite to determining what

evidence may be considered on the issue of "obviousness" is in accord with the pre-1953 practice in this Court. As this Court implicitly recognized, that practice was compelled by the fact that R.S. 4886 contained no directions for determining "obviousness," coupled with the public policy which requires that "time-bars" on statutory rights be strictly confined to the scope defined by Congress.[17]

Exemplary of such recognition is this Court's opinion in *Concrete Appliance Co.* v. *Gomery,* 269 U.S. 177, 180, 70 L.Ed. 222, 225, 46 S.Ct. 42 (1925), wherein the Court observed:

> ". . . the difference in result reached by the two circuit courts [below] leads us to review the salient features of the state of the art at about January 1908, when, according to petitioners, Callahan conceived the combination covered by the claims in his patent."

"Obviousness" was similarly determined on the basis of the state of the art at the invention date in each of the following opinions of this Court: *Electric Cable Joint Co.* v. *Brooklyn Edison Co.,* 292 U.S. 69, 78 L. Ed. 1131, 54 S.Ct. 586 (1934); *Paramount Publix Corp.* v. *American Tri-Ergon Corp.,* 294 U.S. 464, 79 L.Ed. 997, 55 S.Ct. 449 (1935); *Textile Mach. Works* v. *Louis Hirsch Textile Machines,* 302 U.S. 490, 82 L. Ed. 382, 58 S.Ct. 291 (1938), *affirming* 87 F. 2d 702 (2 Cir. 1937); and *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U.S. 350, 83 L.Ed. 1334, 59 S.Ct. 897 (1939).

Far from proceeding "regardless of the applicant's date of invention," this Court always considered it

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[17] See the discussion of petitioner's reason 5, pp. 26-28, *infra.*

necessary to establish that date of invention before deciding what evidence could be considered in evaluating "obviousness." The majority below appears to have been alone in holding otherwise.

5. The Decision Below Is In Direct Conflict With The Decisions Of This Court Construing The "Time-Bar" Provisions Of The Patent Statutes.

The majority below acknowledged that its decision is based upon its own notions of what "Congress could not possibly have intended" (App., p. 22a) rather than the express language of *either* 35 U.S.C. 103 or 35 U.S.C. 102(b). Professing to find "a paucity of direct precedents on the precise problem" (App., p. 19a), it felt free to ignore the clear words of these statutes in favor of a nonexistent "public policy" of its own creation.

Attempts, purportedly justified on "policy" grounds, to change the scope of "time bars" of the patent laws are no novelty. Since at least 1896 this Court has consistently rebuffed such attempts and held to be paramount that policy which requires such "time bars" to be construed in strict conformity with the declarations of Congress.

By 35 U.S.C. 103 Congress guaranteed petitioner the *right* to have the question of obviousness determined in light of "the subject matter as a whole . . . at the time the invention was made". By "interpretation" of 35 U.S.C. 102(b) the decision below denies petitioner that statutory right—and clashes head-on with the repeated rulings of this Court that "a party seeking a right under the patent statutes may avail himself of all their provisions and the courts may not deny him the benefit of a single one." *Overland Motor Co.* v. *Packard Motor Car Co.*, 274 U.S. 417, 71 L.Ed.

1131, 47 S.Ct. 672 (1927); *Chapman* v. *Wintroath,* 252 U.S. 126, 64 L.Ed. 491, 40 S.Ct. 234 (1920); *United States* v. *American Bell Tel. Co.,* 167 U.S. 224, 42 L. Ed. 144, 17 S.Ct. 809 (1897).

In *Chapman,* in holding the "time bar" of R.S. 4886 to be bounded by the precise declaration of Congress, this Court stated:

> "There is no suggestion in the record that the original application of the Chapmans was not prosecuted strictly as required by the statutes and the rules of the Patent Office, and therefore, it is settled, their rights may not be denied or diminished on the ground that such delay may have been prejudicial to either public or private interests. 'A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. No court can disregard any statutory provisions in respect to these matters on the ground that, in its judgment, they were unwise or prejudicial to the interests of the public.' United States v. American Bell Teleph. Co. 167 U.S. 224, 246, 42 L. ed. 144, 155, 17 Sup. Ct. Rep. 809." [252 U.S. at 136, 137; 64 L.Ed. at 495]

The principles enunciated in *Chapman* and *Bell* were reiterated verbatim in rejecting analogous arguments in *Overland.*

Cognizant of the principles enunciated in *Chapman, Overland* and *Bell,* the dissenting judge quite understandably complains:

> *"Even if there were such a pervasive policy, it is an usurpation of the legislative function for this*

court to rewrite the statute. . . ." (Emphasis in original) [18] (App., p. 33a)

6. The Recent Decisions Of The Court Of Customs And Patent Appeals Interpreting 35 U.S.C. 102 and 35 U.S.C. 103 Are In Irreconcilable Conflict.

Illustrative of the conflict are some eight decisions [19] which the court below has rendered since April of 1962 interpreting 35 U.S.C. 102(b) and 35 U.S.C. 103. Five of these decisions [20]—two decided in the spring of 1962, one decided in December 1964, and two decided in April and May of this year—hold that there is a *limitation* on the availability of disclosures in printed publications as time-bars under 35 U.S.C. 102(b), by which such references are distinguished from the larger class of printed publications competent to show obviousness under 35 U.S.C. 103.

Three decisions, of which this case is one,[21]—all rendered this year—hold precisely the contrary.

On May 13, 1965, in *Application of Folkers,* 344 F. 2d 967 (App., pp. 43a-48a), the decision below was reaffirmed and its major principles reiterated in the following language:

> "Whatever right to a patent appellant may have had at the time the invention was made, it has been lost within the meaning of section 102(b) *if,* indeed, the claimed invention *became* obvious to one

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[18] As the dissenting judge demonstrates, there is, of course, no such pervasive policy. (App., pp. 28a-33a)

[19] In addition to *Palmquist,* 319 F.2d 547, overruled in this case.

[20] *Viz.,* the opinions in the *LeGrice, Ruschig, Sheppard, Petering* and *Hughes* cases. [Citations in text, infra, p. 29]

[21] The others are that of the majority in *Folkers* and the *Hassler* decision.

> of ordinary skill in this art through the publication of the reference more than one year before appellant filed his application." (Emphasis by the court) (App., p. 44a) [344 F. 2d at 968]

The decision in this case was again followed and reaffirmed on July 1, 1965 in *Application of Hassler,* — F. 2d — (App., pp. 49a-64a).

In the decision below and in *Folkers* and *Hassler* the court affirmatively held that there is *no distinction* to be drawn between printed publications competent to show that an invention is "described" under 35 U.S.C. 102(b) and those competent under 35 U.S.C. 103 to show that the invention is "obvious."

To reach this remarkable result in the first instance, the majority below ignored its own earlier inconsistent interpretations of the same statutes in *Application of LeGrice,* 301 F. 2d 929 (1962); *Application of Petering,* 301 F. 2d 676 (1962); and *Application of Sheppard,* 339 F. 2d 238 (1964). One week later, in *Application of Ruschig,* 343 F. 2d 965, decided April 22, 1965, the court below veered back to its pre-*Foster* interpretation of those statutes. A scant three weeks after that, the majority in *Folkers* reaffirmed *Foster* and, thus tacitly and temporarily disavowed, without overruling, its prior inconsistent interpretations, including *Ruschig.* By the next week, however, the court below had again re-evaluated these statutes, and in *Application of Hughes,* 345 F. 2d 184, it moved back in the direction of *LeGrice, Petering, Sheppard* and *Ruschig.* Five weeks later, on July 1, 1965, the majority below handed down its opinion in *Hassler.* It disdained the opportunity[22] to salvage some semblance of autonomy

[22] See Judge Smith's separate concurring opinion in Hassler (App., pp. 62a-64a) and the discussion, *infra,* p. 34, concerning it.

in the separate statutory sections and premised its holding upon the majority opinion in this case, without regard to any of *LeGrice, Petering, Sheppard, Ruschig* or *Hughes.*

In *LeGrice,* one of the earliest of these eight cases, the court in 1962 rendered a unanimous, definitive 15-page opinion construing the expression "described in a printed publication" as used in section 102(b). It affirmatively held that there was a strict *limitation* upon the availability of disclosure in printed publications as bars under section 102(b).

LeGrice involved an application for a plant patent. The reference was a printed description of the plant. The record established that those skilled in the art could not reproduce the plant from the printed description. The court held that the reference did not "describe" the invention within the meaning of 35 U.S.C. 102(b). It stated:

> ". . . When used in the Patent Act of 1952, this clause had acquired in the context in which it is used in section 102(b) something other than an 'exact and unequivocal meaning' as a result of the *judicially imposed limitation* that this clause requires that the description of the invention in the printed publication *must be an 'enabling' description. . . .*" [301 F. 2d at 939]

The court made it clear that by an "enabling" description it meant a description which was "practical and complete" which made the invention available to those skilled in the art "as a practically operative means."

The court went on to overrule, qualify, or distinguish other decisions relied upon by the Patent Office as authority that printed publications which merely name

chemical compounds, but do not teach how such compounds could be prepared, are "printed publications" within the meaning of section 102(b). In holding that such references were not "enabling," the court in *LeGrice,* stated:

> ". . . Even in the chemical art, however, where the knowledge of skilled artisans is great, there are *limitations* on the availability of disclosures in printed publications as bars under section 102(b)." [301 F. 2d at 943]

In the 1964 *Sheppard* case, a *chemical case,* the court unanimously extended its ruling in *LeGrice* to section 102(a).

In *Petering* in 1962 the court applied the very *limitation* upon availability of printed publications as bars under section 102(b) which it affirmatively elucidated in its substantially contemporaneous decision in *LeGrice.*

Petering involved a rejection of a group of claims on a *single* reference, namely, a patent to one Karrer.

After consideration of the reference and the requirements of 35 U.S.C. 102(b), including the limitation upon disclosures in printed publications available as bars under that section, it divided the rejected claims in two groups.

With respect to a *first* group of claims, it held that the reference "described" the claimed invention within the meaning of 35 U.S.C. 102(b) and hence was *not* excluded by the limitations of that section because:

> ". . . Karrer has described to those with ordinary skill in this art each of the various premutations [sic] here involved as fully as if he had drawn each structural formula or had written each name. . . . For these reasons, we hold that each compound

> within the limited class in Karrer, . . . has been *described* in a printed publication within the meaning of 35 U.S.C. § 102(b), . . ." (Emphasis by the court) [301 F. 2d at 682]

The court then considered and reversed *both* the section 102 and the section 103 rejections of the *second* group of claims. In so doing, the court carefully defined the distinction which it *then* recognized—but later denied in this case and *Folkers* and *Hassler*—between the *limited* group of printed publications cognizable under 35 U.S.C. 102(b) and the much *broader* group contemplated by 35 U.S.C. 103. It said:

> "Next we consider claims 5, 11 and 12. The compounds encompassed by these claims, reciting as all of them do an ethyl group, C_2H_5, at the 6-position or ethyl groups at the 6- and 7-positions, are not included in the limited class which we find in Karrer. *Therefore, it is our opinion that these compounds have not been described by Karrer within the meaning of 35 U.S.C. § 102(b) and we turn to the question of their obviousness under 35 U.S.C. § 103. . . .*" (Emphasis by the court on the word "described" only) [301 F. 2d at 682, 683]

On April 22, 1965, one week *after* the decision below—but prior to both *Folkers* and *Hassler*—the court considered the *Application of Ruschig,* 343 F. 2d 965. In *Ruschig,* the court ignored this case to follow *Petering.*

In *Ruschig,* the court concluded that there had been a rejection by the Patent Office of all of the claims on the same references under *both* sections 102 and 103, just as there had been in *Petering.* The court asserted:

> "In this situation we have two different issues to deal with, anticipation under section 102 and

> obviousness under section 103. To keep matters clear, we shall deal with them separately." [343 F. 2d at 972]

It then proceeded to "separately" decide these "two different issues" under separate headings in its opinion. Under the heading, "The Board's Own Anticipation Rejection" the court emphasized the very same *limitations* on references available under section 102(b) which it had previously stressed in *Petering* and affirmed in principle in *LeGrice*. It concluded that the references relied upon by the Patent Office were excluded by the limitations of section 102(b) and reversed the "anticipation" rejection under section 102 (b). It then discussed the very *same* reference as applied to the *same* claims under the heading "The Obviousness Rejection". It recognized the very distinction—denied below and in *Folkers* and *Hassler*, but emphasized in *Petering*, *LeGrice* and *Sheppard*—between printed publications competent as "bars" under section 102(b) and those competent only on the issue of "obviousness" under section 103.

Thereafter in *Application of Hughes*, 345 F. 2d 184, the court again affirmatively *acknowledged* what it expressly denied below and in *Folkers* and *Hassler*, namely, the material difference between references available under sections 102 and 103.

Is there, or is there not, a distinction between section 102(b) references and section 103 references and, if so, what is it?

The situation comes full circle in *Hassler*—the court's latest expression on the point. In that case, unlike *Foster* or *Folkers*, the invention—an apparatus—was contended to have been disclosed by the

appellant himself in a newspaper article more than one year before his filing date. Because certain claimed structural details were not precisely disclosed in the article, a question arose concerning whether the rejection before the court was a rejection under section 102 or section 103. The majority did not decide under which section of the statute the rejection had been made, but simply held, citing *Foster,* that the article is "a valid reference under 35 U.S.C. 102(b) *for what is disclosed therein.*" (Emphasis by the Court) (App., p. 51a)

Judge Smith, in his separate concurring opinion, asserted that the result was governed, *inter alia,* by *Sheppard* and *LeGrice* because "the invention was *described* in the printed publication." (App., p. 63a) He further stated:

> "To the extent the resolution of the issue here requires a determination of patentability under section 103, as the majority seems to indicate, I would *reverse* for the reasons more fully elaborated in my dissenting opinion in In re Foster, 52 CCPA —, — F. 2d —, 145 USPQ 166. However, it does not seem to me that this issue is here presented since the publication relied upon 'describes' the claimed invention within the meaning of section 102(b) and the many decisions which have interpreted it. I therefore concur in the result reached but do so solely on this basis." (Emphasis in original) (App., p. 64a)

The hopeless confusion of the court below is grossly prejudicial to the functioning of the patent system. It can be dispelled only by an authoritative decision of this Court.

7. The Majority Opinion Violates Procedural Due Process and Exceeds the Jurisdiction of the Court as Limited by 35 U.S.C. 144.

The uncertainty of the court below concerning the meaning of 35 U.S.C. 102 and 103 has led to grave problems of procedural due process. Consequent from this uncertainty, the Patent Office practice of rejecting claims as "unpatentable over" one or more references has failed to discharge the duty of that Office under 35 U.S.C. 132 to apprise applicants of the precise grounds, statutory and otherwise, for rejection.

The court below, in its turn, has used the ambiguous expression "unpatentable over" to "affirm" the Patent Office upon rejections actually advanced by the court and *never* made by the Patent Office, even as it has done in this case.

It has been demonstrated that the majority below discarded the Patent Office Solicitor's "rejection under section 103" and substituted its own rejection "predicated" on its "construction of 35 U.S.C. 102(b)" (App., p. 22a). It purported to justify this maneuver by its "interpretation" of the words "unpatentable over" employed by both the Examiner and the Board of Appeals.[28]

In his dissent below, Judge Smith cautioned that serious due process problems are engendered by such a *modus operandi*. He said:

> ". . . I am frankly unable to reconcile the procedural due process requirements of 35 U.S.C. 132 with the failure of the Patent Office here to comply with the notice requirements of this section. Certainly one need look no further than the majority

[28] See footnote 10, *supra*, pp. 12-13.

> opinion to see that the words 'unpatentable over' do not impart such information as to enable an applicant to 'judge of the propriety of continuing the prosecution of his application' as contemplated by section 132." (App., pp. 39a-40a)

Despite this caution, the same maneuver, for the very same purpose was again indulged by the majority below one month later in *Application of Folkers,* 344 F. 2d 967 (App., pp. 43a-48a). Judge Smith again dissented. He pointed out:

> "Moreover, just as I cautioned in Foster, we are here confronted with a prime example of denial of procedural due process to an applicant. The majority opinion fails to inform as to the precise ground of rejection in the present case, but proceeds as though the rejection were grounded on section 102(b). My study of the record has convinced me that no such rejection was ever made." (App. pp. 45a-46a)
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> * * * *
>
> "Now appellant learns that what seems to have been a section 103 rejection is here sufficient to raise the issue of loss of right to patent under section 102(b). If I may be permitted an ad hominem, this is truly learning the hard way. For this is one case in which it is painfully clear that the appealed rejection did not provide the applicant 'with such information * * * as may be useful in judging of the propriety of continuing the prosecution of his application,' to which he is entitled under 35 U.S.C. 132. In addition, the present majority seems to have little regard for the jurisdictional limits of this court, in that it now decides an issue that was never presented below. I find nothing in sections 141 through 146 of Title 35 which could, even by the most imaginative lawyer, be interpreted to permit this court to decide

an appeal on the basis of section 102(b) when the only rejection was for obviousness under section 103". (App. pp. 47a-48a)

One week after the *Folkers* decision, in *Application of Hughes,* 345 F. 2d 184, decided May 20, 1965, the majority refused to consider a section *103* rejection urged by the Solicitor when the record made it "clear that the Examiner's action was based on section *102*" [345 F. 2d at 185]. In that majority opinion, written by Judge Smith, the court tacitly admitted its prior errors in *Folkers* and *Foster—viz.,* that it exceeded the limits of its jurisdiction under 35 U.S.C. 144 and condoned a Patent Office violation of procedural due process consequent from failure to give the mandatory notice required by section 132.

After noting that the examiner's action "was based on section 102," the majority in *Hughes* stated:

> "Our appellate jurisdiction is restricted by 35 U.S.C. § 144 to hearing and determining the appeal 'on the evidence produced before the Patent Office.' It seems basic to the concept of procedural due process that an applicant at least be informed of the broad statutory basis for rejecting his claims, so that he may determine what the issues are on which he can or should produce evidence. In order to insure that an applicant be so informed, 35 U.S.C. § 132 requires that whenever a rejection is made, the Commissioner 'shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application * * *.'
>
> * * * *
>
> "We cannot agree with the solicitor that there is no material difference between sections 102 and

103 with respect to an applicant's right to a day in court. *A rejection under section 102 involves a comparison between the subject matter disclosed by the reference and the claimed invention, in order to determine whether the claimed invention is 'described' in the reference. See, e.g., In re Sheppard, 339 F. 2d 238, 52 CCPA 859. Section 103, on the other hand, requires consideration of the differences between the claimed invention and the prior art, for the purpose of determining whether the claimed subject matter as a whole would have been 'obvious' to one of ordinary skill in the art. Thus, the issues arising under the two sections may be vastly different, and may call for the production and introduction of quite different types of evidence.*

"Accordingly, to the extent the board's decision goes beyond the examiner's rejection, which we have found to be for want of novelty under section 102, it will not be considered, since appellant never received adequate notice of any other ground of rejection which may or may not have been relied upon by the Board of Appeals." [345 F. 2d at 185, 186]

The underlined portion of the foregoing quotation is essentially a verbatim reproduction of the major portion of footnote 7 of Judge Smith's dissenting opinion below (App., p. 39a) which the majority had rejected a scant five weeks before *Hughes* was decided.

The "basic . . . concept of procedural due process . . ." by which the court was guided in *Hughes* in refusing to permit the Solicitor to shift the basis of rejection from section 102 to 103 applies, with equal

force, of course, to the shift of the majority below from "the rejection under section 103" urged by the Solicitor, to a new rejection fundamentally "predicated" on its "construction of section 102(b)." (App., p. 22a)

In *Hughes,* Chief Judge Worley and Judge Martin, who concurred in the majority opinion below, dissented from the due process holding of the majority. In their dissent they took the position that the court was entitled to consider the section 103 rejection advanced by the Board because the appellant elected to "waive" his right to due process under certain Patent Office rules which would have afforded an administrative remedy by proceeding directly on appeal. This position of the dissenting judges is a tacit recognition that, absent such an administrative remedy, due process is violated when the court below considers a new rejection not advanced by the Patent Office.

In this case, of course, no such administrative remedy was available from the *sua sponte* assertion by the court of a new rejection not advanced by the Patent Office.

Despite the conflict between *Hughes* and the majority opinion below, the *Hughes* case does not have the effect of overruling or otherwise modifying the decision in this case. Both this case and *Hughes* stand as the law and both the Patent Office and the court below are free to rely upon either in defense of their actions as they may see fit. The need for guidance from this Court on this point is self-evident. Review

should be granted here for the purpose of supplying such guidance.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

EDWARD S. IRONS
1000 Connecticut Avenue, N. W.
Washington, D. C. 20036
Attorney for Petitioner

Of Counsel:

STANLEY M. CLARK
c/o The Firestone Tire & Rubber Company
1200 Firestone Parkway
Akron, Ohio

MARY HELEN SEARS
1000 Connecticut Avenue, N. W.
Washington, D. C. 20036